

**REMARKS**

Reconsideration and allowance of the subject application are respectfully requested.

In this third, non-final action from the Examiner, new rejections are made under 35 U.S.C. §§101 and 103. The preamble of claims 1 and 22 have been amended to recite a "computer program product on a computer-readable medium." In addition, the subject matter of dependent claim 6 has been incorporated into independent claim 1, the subject matter of dependent claim 28 has been incorporated into independent claim 23, and the subject matter of dependent claim 50 has been incorporated into claim 45.

Claims 1-22 stand rejected under 35 U.S.C. §101 alleging that the claim invention is directed to nonstatutory subject matter. This rejection is respectfully traversed.

The Examiner contends that the computer program product recited in claims 1 and 22 fails to "recite a tangible medium to support the program in order to accomplish the steps into a useful result. Absent a computer-readable medium the computer program product as described cannot be implemented therefore no result can be achieved."

Although Applicant does not agree with the Examiner's contentions, the preamble of those claims now clearly recite, in accordance with the Examiner's desire, "a computer program product on a computer-readable medium." Following the Examiner's rationale, the rejection under 35 U.S.C. §101 should now be withdrawn.

Claims 1-7, 12, 14-15, 17, 22-29, 34, 36-39, 44-51, 56, 58-61 and 66 stand rejected under 35 U.S.C. §103(a) as being unpatentable over newly-applied U.S. Patent

6,192,518 to Neal in view of previously-applied U.S. Patent 6,151,643 to Cheng. This rejection is respectfully traversed.

Neal describes distributing software to remote computers by email. Neal has two primary objectives. First, Neal wants to utilize email as the software distribution mechanism. Column 2, lines 20-24. Second, Neal wants to reduce network traffic by specifically determining the state of the remote computer before distributing software installation components to the remote computer. That way only the required installation components need to be distributed. Column 2, lines 30-38. The term "installation components" is defined as including "both software installation files and configuration settings." Column 2, lines 38-40. The flowcharts in Figures 2A-2F illustrate a procedure where a source computer generates a "snapshot" of the software files and software installation components on a source computer 104. The software components "comprise the software files and configurations settings that are required for installing the software application to be distributed." Column 3, lines 19-21. If software files (as opposed to configurations) are in the snapshot, then a "snapshot description" is created by the source computer, as can be seen in Figures 2A and 3B. The snapshot description contains all the information in the snapshot except for the actual software files. The source computer sends the snapshot description by email to the remote computer. The remote computer then determines whether it is using the correct software and/or configurations. If just a configuration needs to be updated, the remote computer can do this from the information in the snapshot. On the other hand, if the remote computer determines that it needs new

files, then the remote computer sends a reply to the initial email requesting the delivery of the necessary files. The source computer then emails the requested files to the remote computer.

The Examiner admits that Neal fails to disclose that the tag is indicative of the existence of an updated version of a computer file. The Examiner asserts that the "use of communication messaging between a server and a client to communicate latest version of software to be installed on receiving client machine was well-known concept at the time the invention was made." Applicant respectfully requests that the Examiner provide a prior art reference to support this "well-known concept" as alleged. The Examiner also contends that Cheng "teaches a [sic] electronic mail to indicate existence of a newer version of software for update."

The Examiner seems to suggest that the claimed tag could be read as either (a) the snapshot description, the existence which is detected, as described generally at column 3, lines 45-67, or (b) specific text in the email subject-field including an "MBA 2.0 tag," as disclosed in column 5, lines 8-17. But it is important to recognize that in Neal, a downloading of an update file from the source computer is only triggered if the remote computer detects, **from the snapshot description file**, that a certain file is required. That download is **not** triggered by the existence of specific text in the subject field. Indeed, MBA 2.0 only serves as an indicator of a specific **type** of email; it does **not** indicate a "version level of said computer file currently used by said computer."

Even if Neal and Cheng could be combined, (for purposes of argument only), the combination fails to teach all the features in the independent claims. In each independent claim, a computer inserts a tag into the data that is processed which indicates the version of the computer file **that computer** is currently using. The Examiner addresses this claim feature on page 5 of the Office Action by arguing that Neal "implicitly discloses inserting code to insert a tag...indicative of a software files [sic] to map and adjust against existing software in the target system." Here, the Examiner relies on columns 5 and 6, which describe the MBA 2.0 tag in the email subject line for emails to both the remote computer 108 and the source computer 104.

Both Neal and Cheng use email to inform **other** computers of something those **other** computers should be using. In contrast, the independent claims recite that a computer inserts a tag within data indicating the version of a computer file **that computer** is using. For example, claim 23 recites a computer "inserting into data being processed by said computer a tag indicative of a version level of said computer file currently used by said computer." Claims 1 and 45 contain similar language. Claims 22, 44 and 66 recite that a tag is inserted "within data indicating a version level of a computer file used by a first computer."

In addition to the combination failing to disclose all of the features recited in the independent claims, the combination proposed by the Examiner is improperly based on hindsight. As the various Federal Circuit cases cited in the previous responses explained, there must be some motivation or teaching in the prior art that leads a person of ordinary

skill in the art to modify and combine Neal and Cheng as proposed by the Examiner. The Examiner is not permitted to simply reconstruct the claim after the fact by selecting various features in the two references while ignoring other teachings of those references. As already admitted by the Examiner, Neal fails to disclose sending the tag to indicate the existence of an updated version of a computer file. That is a major deficiency. In addition, Cheng actually *teaches away* from the claimed invention by advancing a software update approach, not based on detecting embedded tags, but rather based on communications manually-initiated by a human user.

Ignoring these problems in both references, the Examiner constructs a strained and tenuous motivation after the fact. But the reality is that Neal's "trigger code," as referred to by the Examiner, has nothing to do with inserting a tag into data being processed by the computer which indicates a version level of a computer file currently used by that computer. Cheng's software update approach is not initiated or triggered by tags, but rather is manually initiated by a human user. The leap that the Examiner must make to justify the combination of these references can only come from the teachings of the present application.

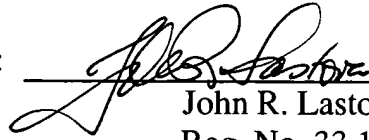
For the reasons set forth above, Applicants respectfully submit that the present application is now in condition for allowance. An early notice to that effect is earnestly solicited.

BARTON  
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Respectfully submitted,

**NIXON & VANDERHYE P.C.**

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